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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/980,845

04/08/2002

Ann Progulske-Fox

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02/17/2009

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EXAMINER

STEELE, AMBER D

ART UNIT

PAPER NUMBER

1639

MAIL DATE

DELIVERY MODE

02/17/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/980,845	<b>Applicant(s)</b> PROGULSKE-FOX ET AL.	
	<b>Examiner</b> AMBER D. STEELE	<b>Art Unit</b> 1639	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 July 2008 and 19 November 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Status of the Claims***

1. The amendment to the claims received on July 18, 2008 amended claims 2-3.  
Claims 1-17 are currently pending and under consideration.

### ***Election/Restrictions***

2. Upon further consideration, at this time, the restriction requirement is withdrawn.  
However, the restriction requirement may be reinstated if necessary.

### ***Priority***

3. The instant application, Serial No. 09/980,845, filed 4/8/2002, states that it is the national stage of PCT/US00/21340, international filing date 8/4/2000; which claims benefit of U.S. Provisional Application 60/147,551, filed 8/6/1999.

### **Withdrawn Objection**

4. The objection to the abstract is withdrawn in view of the abstract received on July 18, 2008.

### **Withdrawn Rejection**

5. The rejection of claims 2-3 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention is withdrawn in view of the claim amendments received on July 18, 2008.

### **Maintained Rejection**

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

***Double Patenting***

7. Claims 1-17 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-11 of U.S. Patent No. 7,033,748 B2. Although the conflicting claims are not identical, they are not patentably distinct from each other.

The instant claims are drawn to a method of identifying a polynucleotide of a microbe that is expressed in vivo comprising the steps of: (a) adsorbing antibodies against antigens that are expressed by the microbe in vivo and in vitro with cells or cellular extracts of the microbe that have been grown in vitro; (b) isolating unadsorbed antibodies; and (c) probing an expression library of the microbe's DNA or RNA with the antibodies of step (b); wherein a polynucleotide of the microbe that is expressed in vivo is isolated and identified; and variations thereof.

Claims 1-11 of the '748 Patent are drawn to a method of identifying a polynucleotide of a microbe that is expressed in vivo comprising the steps of: adsorbing an antibody sample with cells or cellular extracts of the microbe that have been grown in vitro, wherein the antibody sample comprises antibodies specific for antigens expressed by the microbe when grown in vivo and antibodies specific for antigens expressed by the microbe when grown in vitro; isolating unadsorbed antibodies; and probing a phage display library of the microbe's DNA with the unadsorbed antibodies of step (b); wherein the step of probing a phage display library comprises: (i) immobilizing the unadsorbed antibodies on a solid support; (ii) adding the phage display library of the microbe's DNA or RNA to the solid support; (iii) washing unbound phage from the solid support; and (iv) recovering phage that are bound to the solid support; wherein a polynucleotide of the microbe that is expressed in vivo is isolated and identified.

Thus the claims of the '748 Patent anticipates or makes obvious the claims of the instant application, as the species anticipates or makes obvious the genus.

*Arguments and Response*

8. Applicants' arguments directed to the rejection on the ground of nonstatutory obviousness-type double patenting as being unpatentable over U.S. Patent 7,033,748 for claims 1-17 were considered but are not persuasive for the following reasons.

Applicants state that they will consider filing a TD when the claims are otherwise in condition for allowance.

While a request may be made that objections or requirements as to form not necessary to further consideration of the claims be held in abeyance until allowable subject matter is indicated, the present rejection will not be held in abeyance.

*Conclusion*

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

***Future Communications***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to AMBER D. STEELE whose telephone number is (571)272-5538. The examiner can normally be reached on Monday through Friday 9:00AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low can be reached on 571-272-0951. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Amber D. Steele/  
Patent Examiner, Art Unit 1639

February 11, 2009